

Applicant : Joe Z. TSIEN
Application No. : 10/009,228
Filing Date : March 12, 2002
Page : 4

REMARKS

Claims 1-50 were pending in this Application. Claims 1-27 and 35-50 were withdrawn from consideration by the Examiner to whom this application has been assigned. By this Amendment, Applicant has amended Claim 29. Applicant has cancelled claims 1-27 and 35-50 without prejudice to Applicant's right to subsequently pursue the subject matter in the present or future application. Accordingly, there is no issue of new matters and Applicant respectfully requests the entry of this Amendment.

The below objections and rejections were stated in the June 6, 2005 Office Action.

I. Claim Objections

Examiner has objected to Claims 29-34 because they are dependent on Claim 28, which is directed a non-elected invention.

In response, Applicant respectfully requests that Examiner please enter Claim 28 as part of the previously elected invention. Since the Examiner has stated that "claim 28 will be considered as it reads upon a method of identifying compounds that enhance learning and memory by affecting NR2B expression or NMDA activity comprising providing a pair of cells, one of which expresses an exogenous nuclei acid encoding NR2B," the dependency of Claims 29-34 on Claim 28 is proper.

Therefore, Applicant respectfully requests the reconsideration and withdrawal of this ground of rejection.

II. Claim Rejections - 35 U.S.C. § 112, First Paragraph

Applicant : Joe Z. TSIEN
Application No. : 10/009,228
Filing Date : March 12, 2002
Page : 5

Examiner has rejected Claims 28-34 under 35 U.S.C. § 112 because the specification

"does not reasonably provide enablement for a method for identifying compounds that enhance learning and memory in a subject by increasing expression of [or activity of nmda receptors] nr2b in a subject which comprises exposing a cell in vitro to a test compound suspected of upregulating nr2b wherein the determining step comprises comparing NMDA receptor function of said transgenic cell comprising an exogenous nucleic acid molecule encoding nr2b, wherein a change in the NMDA receptor function in the treated, non-transgenic cell that comprises the same features of the NMDA receptor function exhibited in the transgenic cell being indicative that the test compound enhances learning and memory in a subject by affecting nr2b expression or NMDA receptor activity." See page 4, lines 8-18

Further, the Examiner comments that "the art is *highly unpredictable* for identifying a compound as claimed in claims 29-34." See page 7, this Office Action, lines 9-10

In response, Applicant respectfully traverses the Examiner's above ground of rejection. Applicant maintains that the claimed invention is fully enabled as filed. As shown in the specification, the test compound has enhanced learning and memory. Therefore, Applicant respectfully requests the reconsideration and withdrawal of this ground of rejection.

III. Claim Rejections 35 U.S.C. § 112, Second Paragraph

Examiner has rejected Claim 29-34 under 35 U.S.C. § 112, second paragraph. Examiner has stated that "the term 'comprises the same features' in claim 29 is a relative term which renders the claim indefinite."

In response, but without conceding the correctness of the Examiner's position and to expedite the prosecution of this application, Applicant has herein above amended Claim 29 to

Applicant : Joe Z. TSIEN
Application No. : 10/009,228
Filing Date : March 12, 2002
Page : 6

delete the term "comprises the same features." Therefore, this line of rejection is rendered moot.

CONCLUSION

Applicant respectfully contends that the Examiner's objections and/or rejections raised in this Office action have been fully addressed, and therefore this Application is in full compliance with all requirements. Accordingly, Applicant respectfully urges the Examiner to reconsider and withdraw all objections and/or rejections in this Office action and place this application in conditions for allowance.

If a telephone interview would be of assistance in advancing prosecution of the subject application, Applicant's undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee other than the FIVE HUNDRED TEN DOLLARS (\$510.00) FOR THE THREE MONTH EXTENSION OF TIME FEE is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 50-1891.

Respectfully submitted,

Albert Wai Kit Chan

Albert Wai-Kit Chan
Registration No. 36,479
Attorney for Applicant(s)
Law Offices of
Albert Wai-Kit Chan, LLC
World Plaza, Suite 604
141-07 20th Avenue
Whitestone, New York 11357
Tel: (718) 799-1000
Fax: (718) 357-8615
Email: chank@kitchanlaw.com

I hereby certify that this paper is being deposited this date with the U.S. Postal Service with sufficient postage for first class mail addressed to: Mail Stop Missing Parts, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Albert Wai Kit Chan 12/6/01
Albert Wai-Kit Chan Date
Reg. No. 36,479